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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,595	09/25/2003	Kouji Yokouchi	2091-0289P	1313

2292 7590 07/06/2005	EXAMINER
BIRCH STEWART KOLASCH & BIRCH	PHUONG, DAI

	ART UNIT	PAPER NUMBER
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DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/669,595	YOKOUCHI, KOUJI
	Examiner	Art Unit	
	Dai A Phuong	2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 September 2003*.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some *   c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims **21-30** are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

The claims are drawn to a "program" *per se* as recited in each preamble and as such are drawn to

non-statutory subject matter.   See MPEP § 2106.IV.B.1.a.   Data structures not claimed as

embodied in computer readable media are descriptive material *per se* and are not statutory

because they are not capable of causing functional change in the computer.   See, e.g.,

Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held

nonstatutory).   Such claimed data structures do not define any structural and functional

interrelationships between the data structure and other claimed aspects of the invention, which

permit the data structure's functionality to be realized.   In contrast, a claimed computer readable

medium encoded with a data structure defines structural and functional interrelationships

between the data structure and the computer software and hardware components which permit

the data structure's functionality to be realized, and is thus statutory.   Similarly, computer

programs claimed as computer listings *per se*, i.e., the descriptions or expressions of the

programs are not physical "things."   They are neither computer components nor statutory

processes, as they are not "acts" being performed.   Such claimed computer programs do not

define any structural and functional interrelationships between the computer program and other

claimed elements of a computer, which permit the computer program's functionality to be

realized.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
> in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
> patent by another filed in the United States before the invention by the applicant for patent, except that an
> international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
> subsection of an application filed in the United States only if the international application designated the United
> States and was published under Article 21(2) of such treaty in the English language.

3.   Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Carter et al.

(Pub. No: 2004/0054732)

Regarding claim 1, Carter et al. disclose an E-mail sending method for sending an E-mail

message from a sender terminal to a recipient mobile terminal as a destination of the E-mail

message (fig. 1, [0036]. Specifically, Carter et al. recite data processing system 300 (client

computer 108, 110 and 112) may also be a **notebook computer or hand held computer** in

addition to taking the form of a **PDA** in section [0035] and **client 114 may be a cellular phone**

with an integrated browser to access the network or any wireless data communications system in

section [0026]), the method comprising the steps of: storing the E-mail message sent with a

reception location being specified by the sender terminal ([0042] and [0046].); making a

judgment as to whether or not the recipient mobile terminal is at the reception location ([0053] to

[0054]); and sending the E-mail message to the recipient mobile terminal in the case where a

result of the judgment is affirmative ([0053] to [0054]).

Regarding claim 2, Carter et al. disclose all the limitation in claim 1. Further, Carter et

al. disclose the E-mail sending method wherein, in the case where the E-mail message sent from

the sender terminal designates reception time ([0058] to [0059]), the step of making a judgment is the step of making a judgment as to whether or not the reception time has come, in addition to the judgment as to whether or not the recipient mobile terminal is at the reception location ([0063]), and wherein the step of sending the E-mail message is the step of sending the E-mail message to the recipient mobile terminal in the case where a result of the judgment as to whether or not the reception time has come becomes affirmative and the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is also affirmative ([0063]).

Regarding claim 3, Carter et al. disclose all the limitation in claim 2. Further, Carter et al. disclose the E-mail sending method further comprising the step of sending the E-mail message to the recipient mobile terminal in the case where the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is negative after a predetermined time has elapsed since starting of the judgment as to whether or not the reception time has come ([0061] to [0062]).

Regarding claim 4, Carter et al. disclose all the limitation in claim 1. Further, Carter et al. disclose the E-mail sending method further comprising the step of sending the E-mail message to the recipient mobile terminal in the case where the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is negative after a predetermined time has elapsed since transmission of the E-mail message by the sender terminal ([0061] to [0062]).

Regarding claim 5, Carter et al. disclose all the limitation in claim 3. Further, Carter et al. disclose the E-mail sending method further comprising the step of sending an E-mail message to the sender terminal for notifying that the E-mail message has been sent ([0044] to [0045]).

Regarding claim 6, Carter et al. disclose all the limitation in claim 4. Further, Carter et al. disclose the E-mail sending method further comprising the step of sending an E-mail message to the sender terminal for notifying that the E-mail message has been sent ([0044] to [0045]).

Regarding claim 7, Carter et al. disclose an E-mail reception method for receiving an E-mail message by using a recipient mobile terminal as a destination of the E-mail message, the E-mail message being sent from a sender terminal and stored in a mail server ([0047]), the method comprising the steps of: making a judgment as to whether or not the recipient mobile terminal is in a reception location in the case where the E-mail message was sent in a state where the reception location was specified by the sender terminal ([0053] to [0054]); and instructing the mail server to cause the recipient mobile terminal to receive the E-mail message in the case where a result of the judgment is affirmative ([0053] to [0054]).

Regarding claim 8, Carter et al. disclose all the limitation in claim 7. Further, Carter et al. disclose the E-mail reception method wherein, in the case where the E-mail message sent from the sender terminal designates reception time ([0059]), the step of making a judgment is the step of making a judgment as to whether or not the reception time has come, in addition to the judgment as to whether or not the recipient mobile terminal is at the reception location ([0062] to[0063]), and wherein the step of instructing the mail server is the step of instructing the mail server to cause the recipient mobile terminal to receive the E-mail message, in the case where a

result of the judgment as to whether or not the reception time has come becomes affirmative and the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is also affirmative ([0062] to[0063]).

Regarding claim 9, Carter et al. disclose all the limitation in claim 9. Further, Carter et al. disclose the E-mail reception method further comprising the step of: instructing the mail server to cause the recipient mobile terminal to receive the E-mail message, in the case where the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is negative after a predetermined time has elapsed since starting of the judgment as to whether or not the reception time has come ([0061] to [0062]).

Regarding claim 10, Carter et al. disclose all the limitation in claim 7. Further, Carter et al. disclose the E-mail reception method further comprising the step of instructing the mail server to cause the recipient mobile terminal to receive the E-mail message, in the case where the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is negative after a predetermined time has elapsed since the sender terminal sent the E-mail message ([0061] to [0062]).

Regarding claim 11, Carter et al. disclose an E-mail sending apparatus for sending an E-mail message sent from a sender terminal to a recipient mobile terminal as a destination of the E-mail message ([0047]), the apparatus comprising: mail storage 104 means for storing the E-mail message sent with a reception location being specified by the sender terminal (fig. 2, [0027] and [0047]); position judgment means for making a judgment as to whether or not the recipient mobile terminal is at the reception location ([0047] and [0054]); and transmission control 202

(fig. 2, [0027])means for sending the E-mail message to the recipient mobile terminal only in the case where a result of the judgment is affirmative ([0053]).

Regarding claim 12, Carter et al. disclose all the limitation in claim 11. Further, Carter et al. disclose the E-mail sending apparatus wherein, in the case where the E-mail message sent from the sender terminal designates reception time ([0059]), the judgment means makes a judgment as to whether or not the reception time has come, in addition to the judgment as to whether or not the recipient mobile terminal is at the reception location ([0062] to [0063]) and the transmission control means sends the E-mail message to the recipient mobile terminal in the case where a result of the judgment about the reception time becomes affirmative and the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is also affirmative ([0062] to[0063]).

Regarding claim 13, Carter et al. disclose all the limitation in claim 12. Further, Carter et al. disclose the E-mail sending apparatus wherein the transmission control 202 means sends the E-mail message to the recipient mobile terminal in the case where the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is negative after a predetermined time has elapsed since starting of the judgment as to whether or not the reception time has come ([0061] to [0062]).

Regarding claim 14, E-mail sending apparatus according to claim 11, wherein the transmission control 202 means sends the E-mail message to the recipient mobile terminal in the case where the result of the judgment as to whether or not the recipient mobile terminal is at the

reception location is negative after a predetermined time has elapsed since the sender terminal sent the E-mail message ([0061] to [0062]).

Regarding claim 15, Carter et al. disclose all the limitation in claim 13. Further, Carter et al. disclose the E-mail sending apparatus wherein the transmission control 202 means sends an E-mail message to notify the sender terminal that the E-mail message has been sent ([0044] to [0045]).

Regarding claim 16, E-mail sending apparatus according to claim 14, wherein the transmission control 202 means sends an E-mail message to notify the sender terminal that the E-mail message has been sent ([0044] to [0045]).

Regarding claim 17, Carter et al. disclose an E-mail reception apparatus for receiving an E-mail message by using a recipient mobile terminal as a destination of the E-mail message, the E-mail message being sent from a sender terminal and stored in a mail server ([0047]), the E-mail reception apparatus comprising: position judgment means for making a judgment as to whether or not the recipient mobile terminal is in a reception location in the case where the E-mail message was sent in a state where the reception location was specified by the sender terminal ([0053] to [0054]); and transmission control 202 means for instructing the mail server to cause the recipient mobile terminal to receive the E-mail message in the case where a result of the judgment is affirmative ([0044] to [0045]).

Regarding claim 18, Carter et al. disclose all the limitation in claim 17. Further, Carter et al. disclose the E-mail reception apparatus wherein, in the case where the E-mail message sent from the sender terminal designates reception time ([0059]), the position judgment means makes

a judgment as to whether or not the reception time has come, in addition to the judgment as to whether or not the recipient mobile terminal is at the reception location ([0047] and [0053] to 0054]), and the transmission control means instructs the mail server to cause the recipient mobile terminal to receive the E-mail message in the case where a result of the judgment as to whether or not the reception time has come becomes affirmative and the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is also affirmative ([0058] to [0059] and [0061] to[0062]).

Regarding claim 19, Carter et al. disclose all the limitation in claim 18. Further, Carter et al. disclose the E-mail reception apparatus wherein the position judgment means instructs the mail server to cause the recipient mobile terminal to receive the E-mail message, in the case where the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is negative after a predetermined time has elapsed since starting of the judgment as to whether or not the reception time has come ([0062] to [0063]).

Regarding claim 20, Carter et al. disclose all the limitation in claim 17. Further, Carter et al. disclose the E-mail reception apparatus wherein the position judgment means instructs the mail server to cause the recipient mobile terminal to receive the E-mail message, in the case where the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is negative after a predetermined time has elapsed since the sender terminal sent the E-mail message ([0062] to [0063]).

Regarding claim 21, Carter et al. disclose a program for causing a computer to execute an E-mail sending method for sending an E-mail message from a sender terminal to a recipient

mobile terminal as a destination of the E-mail message, the program comprising the steps of:

storing the E-mail message sent with a reception location being specified by the sender terminal

([0042] and [0046]. Inherently, the client computers and server 104 include a program which

instructs these microprocessors to perform these functions); making a judgment as to whether or

not the recipient mobile terminal is at the reception location ([0047] and [0053] to [0054].

Inherently, the client computers and server 104 include a program which instructs these

microprocessors to perform these functions); and sending the E-mail message to the recipient

mobile terminal in the case where a result of the judgment is affirmative ([0053] to [0054].

Inherently, the client computers and server 104 include a program for instructing these

microprocessors to perform these functions).

Regarding claim 22, Carter et al. disclose all the limitation in claim 21. Further, Carter et

al. disclose the program wherein, in the case where the E-mail message sent from the sender

terminal designates reception time ([0059]), the step of making a judgment is the step of making

a judgment as to whether or not the reception time has come, in addition to the judgment as to

whether or not the recipient mobile terminal is at the reception location ([0058] to [0059] and

([0061] to [0062]. Inherently, the client computers and server 104 include a program which

instructs these microprocessors to perform these functions), and wherein the step of sending the

E-mail message is the step of sending the E-mail message to the recipient mobile terminal in the

case where a result of the judgment as to whether or not the reception time has come becomes

affirmative and the result of the judgment as to whether or not the recipient mobile terminal is at

the reception location is also affirmative ([0058] to [0059] and ([0061] to [0062]. Inherently, the

client computers and server 104 include a program for instructing these microprocessors to perform these functions).

Regarding claim 23, Carter et al. disclose all the limitation in claim 22. Further, Carter et al. disclose the program further comprising the step of sending the E-mail message to the recipient mobile terminal in the case where the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is negative after a predetermined time has elapsed since starting of the judgment as to whether or not the reception time has come ([0062] to [0063]. Inherently, the client computers and server 104 include a program for instructing these microprocessors to perform these functions).

Regarding claim 24, Carter et al. disclose all the limitation in claim 21. Further, Carter et al. disclose the program further comprising the step of sending the E-mail message to the recipient mobile terminal in the case where the result of the judgment as to whether or not the recipient mobile terminal is at the reception location is negative after a predetermined time has elapsed since transmission of the E-mail message by the sender terminal ([0062] to [0063]. Inherently, the client computers and server 104 include a program for instructing these microprocessors to perform these functions).

Regarding claim 25, Carter et al. disclose all the limitation in claim 23. Further, Carter et al. disclose the program further comprising the step of sending an E-mail message to the sender terminal for notifying that the E-mail message has been sent ([0044] to [0045]. Inherently, the client computers and server 104 include a program for instructing these microprocessors to perform these functions).

Regarding claim 26, Carter et al. disclose all the limitation in claim 24. Further, Carter et al. disclose the program further comprising the step of sending an E-mail message to the sender terminal for notifying that the E-mail message has been sent ([0044] to [0045]. Inherently, the client computers and server 104 include a program for instructing these microprocessors to perform these functions).

Regarding claim 27, Carter et al. a program for causing a computer to execute an E-mail reception method for receiving an E-mail message by using a recipient mobile terminal as a destination of the E-mail message, the E-mail message being sent from a sender terminal and stored in a mail server ([0047]), the program comprising the steps of: making a judgment as to whether or not the recipient mobile terminal is in a reception location in the case where the E-mail message was sent in a state where the reception location was specified by the sender terminal ([0053] to [0054]. Inherently, the client computers and server 104 include a program which instructs these microprocessors to perform these functions); and instructing the mail server to cause the recipient mobile terminal to receive the E-mail message in the case where a result of the judgment is affirmative ([0053] to [0054]. Inherently, the client computers and server 104 include a program for instructing these microprocessors to perform these functions).

Regarding claim 28, Carter et al. disclose all the limitation in claim 27. Further, Carter et al. disclose the program according wherein, in the case where the E-mail message sent from the sender terminal designates reception time ([0059]), the step of making a judgment is the step of making a judgment as to whether or not the reception time has come, in addition to the judgment as to whether or not the recipient mobile terminal is at the reception location ([0058] to [0059] and [0061] to [0062]. Inherently, the client computers and server 104 include a program for

instructing these microprocessors to perform these functions), and wherein the step of instructing

the mail server is the step of instructing the mail server to cause the recipient mobile terminal to

receive the E-mail message, in the case where a result of the judgment as to whether or not the

reception time has come becomes affirmative and the result of the judgment as to whether or not

the recipient mobile terminal is at the reception location is also affirmative ([0058] to [0059] and

[0061] to [0062]. Inherently, the client computers and server 104 include a program for

instructing these microprocessors to perform these functions).

Regarding claim 29, Carter et al. disclose all the limitation in claim 28. Further, Carter et

al. disclose the program further comprising the step of: instructing the mail server to cause the

recipient mobile terminal to receive the E-mail message, in the case where the result of the

judgment as to whether or not the recipient mobile terminal is at the reception location is

negative after a predetermined time has elapsed since starting of the judgment as to whether or

not the reception time has come ([0062] to [0063]. Inherently, the client computers and server

104 include a program for instructing these microprocessors to perform these functions).

Regarding claim 30, Carter et al. disclose all the limitation in claim 27. Further, Carter et

al. disclose the program further comprising the step of instructing the mail server to cause the

recipient mobile terminal to receive the E-mail message, in the case where the result of the

judgment as to whether or not the recipient mobile terminal is at the reception location is

negative after a predetermined time has elapsed since the sender terminal sent the E-mail

message ([0062] to [0063]. Inherently, the client computers and server 104 include a program

for instructing these microprocessors to perform these functions).

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Suzuki et al. (Pub. No: 20030158904) e-mail server and service email

Perrella et al. (Pub. No: 20030004776) location and time sensitive wireless calendaring

Gehlot et al. (Pub. No: 20030154126) offering advertising over the internet

Hirabayashi et al. (Pub. No: 20020059178) information management

Hendrey et al. (Pub. No: 20020102993) advertisement delivered to a mobile unit

5.   Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Dai A Phuong whose telephone number is 571-272-7896. The
examiner can normally be reached on Monday to Friday, 9:00 A.M. to 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Edward Urban can be reached on 703-305-4385. The fax phone number for the
organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published applications
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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR
system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dai Phuong
AU: 2685
Date: 06-23-2005

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